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IN THE

Supreme Court of the United States

____ TERM, 1975

No. _____

OLYMPIC FASTENING SYSTEMS, INC.,

Petitioner,

v.

TEXTRON, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Petitioner, OLYMPIC FASTENING SYSTEMS, INC., prays that a writ of certiorari be issued to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in the case of *OLYMPIC FASTENING SYSTEMS, INC.* v. *TEXTRON, INC.*, which reversed the judgment of the United States District Court for the Southern District of Ohio, Western Division, holding Respondent's United States Patent No. 2,931,532 valid but not infringed. (Petitioner OLYMPIC FASTENING SYSTEMS, INC. will be hereinafter referred to as "OLYMPIC" and Respondent TEXTRON, INC. as "TEXTRON").

OPINIONS BELOW

The as yet unreported Memorandum Opinion of the District Court is appended hereto as Appendix A, at pages 1a-19a; and Final Judgment was entered on September 17, 1973, Appendix A, at page 20a.

The opinion of the Court of Appeals for the Sixth Circuit, reported at __ F. 2d __, 183 USPQ 449 (6th Cir. 1974) is appended hereto as Appendix B, at pages 21a-43a.

JURISDICTION

The judgment of the Court of Appeals for the Sixth Circuit was entered on October 16, 1974, and OLYMPIC'S Petition for Rehearing was denied on November 22, 1974, pursuant to an Order annexed in Appendix B, at page 44a.

The jurisdiction of this Court is invoked under Section 1254(1) of Title 28, United States Code.

QUESTIONS PRESENTED

1. May narrowing limitations intentionally added to a patent claim in order to secure its allowance over the cited prior art be disregarded by the Court below in interpreting the scope of the claim to find infringement, in view of the rule of patent claim construction repeatedly enunciated by this Court that claims which have been intentionally narrowed in scope to obtain issuance of a patent cannot be broadened to cover that which was previously by limitation eliminated from the patent?

2. Is not 35 U.S.C. § 251 (Reissue of defective patents) the sole and exclusively remedy for a patentee who has claimed in his patent less than he had a right to claim, and is it not in direct conflict with 35 U.S.C. § 251 for the Court below to effect judicial reissue of a patent claim by disregarding narrowing limitations intentionally added to

the claim, thereby enlarging the scope of the claim to encompass subject matter which the patentee had expressly disclaimed?

3. Is the right of the public to rely on the doctrine of intervening rights, as embodied in 35 U.S.C. § 252 (Effect of reissue), abridged where the Court below, by judicial interpretation, enlarges the scope of a patent claim to cover subject matter expressly excluded by the narrower claim language accepted by the patentee as defining his invention?

STATUTES INVOLVED

This is a patent case under Title 35, United States Code, Patents, Act of July 19, 1952, with particular reference to 35 U.S.C. § 271 (Infringement of patent), this request for review being directed specifically to the patent reissue statutes, 35 U.S.C. § 251 (Reissue of defective patents) and 35 U.S.C. § 252 (Effect of reissue), which statutes are set forth in annexed Appendix C, at pages 45a-47a.

STATEMENT OF THE CASE

This case involves the infringement of United States Letters Patent No. 2,931,532 (Pl. Ex. 2, C.A. App. 339a-342a, R. 172),[1] known as the Gapp patent, relating to a blind rivet for fastening together two or more pieces of metal.[2] OLYMPIC, which is a California corporation and a wholly owned subsidiary of Armco Steel Corporation, filed a Complaint for declaratory judgment against TEXTRON, a Delaware corporation, the owner of the Gapp patent, alleging patent invalidity, and that certain rivets

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[1] "A. -a" refers to pages of the Appendix appended hereto; 'C.A. APP. -a" refers to the Appendix filed in the Court of Appeals, a copy of which is being filed with this Petition; and "R. -" refers to the Record in the District Court.

[2] A brief background explanation of blind rivets will be found in Appendix D, at p. 48a.

manufactured and sold by OLYMPIC under its trademark "OLYMPIC-LOK" do not infringe the Gapp patent. TEXTRON counterclaimed for declaratory judgment alleging that the "OLYMPIC-LOK" rivet is covered by the Gapp patent and that OLYMPIC is under obligation to pay Respondent royalties on its "OLYMPIC-LOK" rivets pursuant to a license agreement between the parties covering the Gapp patent.

Federal jurisdiction in the District Court, as to the parties involved and the subject matter, was based on the patent laws of the United States, in accordance with Title 28 U.S.C., Sections 1338(a), 1331(a), 1332(a)(1) and 2201, venue within the judicial district being in accordance with Title 28 U.S.C. Section 1391(c).

The District Court found the Gapp patent valid but not infringed. The decision of the District Court upholding the validity of the Gapp patent was not appealed; the only questions presented on appeal related to infringement. OLYMPIC presented three arguments in both the District Court and the Court of Appeals in support of its contention that its "OLYMPIC-LOK" rivet did not infringe Claim 1 (the claim in issue) of the Gapp patent. Each of these arguments, characterized by the parties as the "sub-issues" of infringement, was based on the fact that three separate and distinct narrowing limitations had been added to the Gapp claim to secure its allowance, and since none of these limitations is embodied in the "OLYMPIC-LOK" rivet, the claim is not infringed.

The claim reads as follows, the narrowing limitations in question being italicized and identified in the margin:

> "A rivet assembly for tightly securing plates together under stress of use, said rivet assembly including a tubular rivet for snugly fitting into aligned holes in the plates to be riveted, said tubular rivet having a shank and a head

on one end of the shank and a tail on the other end of said shank, said shank and said tail being of substantially the same outer diameter throughout their entire combined length and of smaller diameter than said head, a stem extending through said tubular rivet tail, shank and head, said stem consisting of a pulling portion extending beyond said head and being readily slidable through said tubular rivet, and an elongated and radially enlarged blind head extending beyond

Sub-issue 1 the blind end of said pulling portion, *said blind head being of substantially uniform diameter throughout its length*, and a joining portion between said pulling portion and said blind head, said joining portion tapering outwardly from said pulling portion to said enlarged blind head and being adjacent the tail of said tubular rivet, the angle of said taper and said substantially uniform blind head diameter and the wiredrawability of said tapered portion and said substantially uniform blind head being such that with the rivet snugly fitting into the aligned holes the tapered joining portion, upon reaching the region of the adjacent plate, will fully clinch

Sub-issue 2 the plates and *completely expand the rivet tail against the corners of the hole in the adjacent plate in a single head-forming operation to the finished size of said clinching tail*, and after said clinching and complete tail formation said tapered joining portion and blind head

Sub-issue 3 will be wiredrawn as said *joining portion and said blind head are pulled into and through said tubular rivet* for expanding the shank of the latter tightly against the sides of said holes in said plates."

For the Court's convenience, the critical prosecution of the claim as to each of the sub-issues is traced in annexed Appendix E, commencing at A. 50a.

In essence, it was (and is) OLYMPIC'S position that its rivets do not infringe the above quoted claim for the following reasons:

> (1) The blind head of the stem of the "OLYMPIC-LOK" rivet is *not* of uniform diameter throughout its length, as required by the claim;
>
> (2) The tapered joining portion of the stem of the "OLYMPIC-LOK" rivet does *not* completely expand the rivet tail against the corners of the hole in the adjacent plate in a single head-forming operation to the finished size of the clinching tail, as required by the claim; and
>
> (3) The joining portion and blind head of the stem of the "OLYMPIC-LOK" rivet are *not* pulled into and through the tubular portion of the rivet in setting the rivet, as also required by the claim.

The District Court rejected OLYMPIC'S position on sub-issues 1 and 2, finding infringement, but agreed with OLYMPIC'S position on sub-issue 3, and this finding of noninfringement on sub-issue 3 disposed of the case since a device not responding to any one or more requirements of a claim cannot infringe.

The Court of Appeals affirmed the District Court on sub-issues 1 and 2, but reversed on sub-issue 3 for entry of a finding of infringement and further proceedings on TEXTRON'S counterclaim for royalties.

Significant to this petition is the following reasoning by the Court of Appeals in finding infringement under sub-issue 2 (A. 40a):

> "The Olympic-Lok device *does not appear to be a literal infringement on the language of the Gapp Claim.* The district court reasoned that the critical inventive step in the Gapp patent is tail upset to provide clinching. There is substantial evidence in the record to support his conclusion that this function is performed in the same way and at the same stage in

> the operation of the two devices. *Thus he treated the language in the Gapp patent that tail formation is completed to its finished size at the initial clinching as unimportant.* This language does not appear to be an express limitation on the inventive concept. If an express limitation does not 'pertain to the inventive step but rather to its mere environment,' it does not preclude reliance on the doctrine of equivalents to protect against infringement. United Shoe Machinery Corp. v. O'Donnell Rubber Products Co., supra, 84 F. 2d at 386. Under the doctrine of equivalents 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.' Graver Manufacturing Co. v. Linde Air Products Co., supra, 339 U.S. at 608. A finding of equivalence is a determination of fact which may not be disturbed unless clearly erroneous. Id. at 609-610. The finding of the district court on this sub-issue is not clearly erroneous." (emphasis added)

An inherent defect in the decision below lies in the application of an incorrect standard relating to the doctrine of equivalents under circumstances where the patentee has intentionally and purposefully narrowed his claim to obtain its allowance. The rule of law applied by the Sixth Circuit, as embodied in *United States Shoe Corp.* v. *O'Donnell Rubber Products Co.*, 84 F. 2d 383, 386, relied on below, is inapplicable to a situation where a claim was intentionally limited by the patentee as well as in direct conflict with the decisions of this Court dealing with the interpretation of patent claims under such circumstances, as exemplified by *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 86 L.Ed. 736, 744, (1940) and other decisions discussed in the argument which follows.

We do not quarrel with the conclusion below that the critical inventive step of the Gapp invention is tail upset to provide clinching; but the salient point is that this is

not what the patentee claimed as his invention. Rather, he saw and claimed—and was required by the Patent Office to claim—an invention of narrower scope embodying only the specific combination and arrangement of parts set forth in the claim as finally allowed by the Patent Office. It was the Court—not the inventor—which ultimately defined the scope of the invention and recognized that the inventor had claimed less than he had a right to claim; and it was the Court which cast aside those intentionally added narrowing limitations by according to the claim a broadening scope which encompasses subject matter the patentee had expressly disclaimed as constituting his invention.

There is a significant and material difference between, on the one hand, according to a deserving patentee a reasonable range of equivalents as fairly embraced within the language of his claim and, on the other hand, disregarding as "unimportant" or not "an express limitation on the inventive concept" limitations intentionally added to the claim to secure its allowance. In net effect, the Court below has broadened the *scope* of the claim, which in the words of the patent reissue statute, contemplates "the patentee claiming . . . less than he had a right to claim in the patent." While done under the guise of equivalency, the Court has, in fact, effected a judicial reissue of the Gapp patent—an act which, we submit, is in direct conflict with the patent reissue statute.[3]

Under the reissue statute, no reissue patent may be granted enlarging the breadth of a claim unless applied for within two years from the grant of the original patent. Yet the Court below has sanctioned an enlargement of the Gapp claim some fourteen years after the issuance of the patent.[4] Even where a broadening reissue

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[3] 35 U.S.C. 251, 1st para., quoted at A. 45a.
[4] The Gapp patent issued on April 5, 1960.

is permitted by statute, the rights of the public are carefully safeguarded in that so-called "intervening rights," including freedom from liability for past infringement, are accorded to one who manufactures and/or sells an article between the grant of the original patent which does not specifically cover such article, and the granting of a reissue patent which broadens the scope of the claims to cover such article.[5] In short, the mandate of the statute is that the public is entitled to rely on the patentee's statement of what he believes his invention to be, as set forth in his claims as originally granted, and the public is protected where it acts in reliance on such statements. By contrast, in the present case, the Court below has denied the public its statutory right to rely on the patentee's own definition of his invention, as well as the protection afforded to the public where it acts in reliance on the patentee's own definition of his invention.

Each of the sub-issues poses the same basic questions, varying only in the rationale applied by the Court below in justifying the enlargement of the patentee's claim to encompass subject matter expressly disclaimed by the patentee as constituting his invention. A more detailed discussion of the Court's rationale with respect to each of the sub-issues also will be found in Appendix E, commencing at A. 50a.

REASONS FOR GRANTING CERTIORARI

We respectfully submit that each of the three questions presented warrants review by this Supreme Court in the public interest, with particular reference to the right of the public to enjoy that which a patentee has disclaimed as constituting his invention, as well as the public right to be protected from a charge of infringement where

[5] 35 U.S.C. 252, 2d para., quoted at A. 46a.

reliance is placed on a patentee's own definition of the metes and bounds of his invention.

Question 1 frames the conflict which exists between the rule of claim construction repeatedly enunciated by this Court and the less exacting rule applied by the Court below which has no applicability where narrowing limitations have been intentionally added to a claim. We note that this Court has not directly spoken on this question for over 30 years, and it is submitted that the question warrants review by this Court to make clear to the Courts below the correct rule of law to be followed in interpreting patent claims which have been intentionally limited.

Questions 2 and 3, insofar as we are aware, are questions of first impression, born of the abandonment by the Sixth Circuit Court of Appeals of long established principles of patent claim interpretation. The conflict between the action by the Court below and the mandate of the reissue statutes is a real one, going to the vital questions of who is empowered to revise a patent claim and under what circumstances and conditions, as well as the paramount question of safeguarding the rights of the public to use and enjoy that which has been expressly disclaimed.

I. The Conflict With Decisions By This Court.

An appropriate place of beginning is the decision by this Court in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 86 L.Ed. 736, 744, (1941), wherein this Court clearly states the rule as follows:

> "Whatever may be the appropriate scope and application of the doctrine of equivalents where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.
>
> "Assuming that the patentee would have been entitled to equivalents embracing the accused devices had

> he originally claimed a 'conductor means embedded in the table,' a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one 'carried by the table.'"

Similarly, in *Smith* v. *Magic City Kennel Club*, 282 U.S. 784, 790, 75 L.Ed. 707, (1931), this Court stated:

> "The petitioner resorts to the doctrine of equivalents, insisting that the rigid horizontal arm of the respondents is to be treated as the equivalent of the arm of the patent, and that the limiting specifications of the claims may be ignored. What has already been said disposes of this contention, for where a patentee has narowed his claim, in order to escape rejection, he may not, 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer.' Weber Electric Co. v. E. H. Freeman Electric Co., 256 U.S. 668, 677, 65 L.Ed. 1162, 1167, 1168, 41 S. Ct. 600; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 71 L.Ed. 335, 47 S. Ct. 136, supra. . . .".

Other pertinent decisions by this Court to the same effect include: *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U.S. 222, 227, 26 L.Ed. 149 (1880); *Roemer* v. *Peddie*, 132 U.S. 313, 317, 37 L.Ed. 382 (1889); *Hubbell* v. *United States*, 179 U.S. 77, 80, 45 L.Ed. 95 (1900); *I.T.S. Rubber Co.* v. *Essex Rubber Co.*, 272 U.S. 429, 71 L.Ed. 335 (1926); *Keystone Co.* v. *Northwest Eng. Co.*, 294 U.S. 42, 48, 79 L.Ed. 747 (1935); *Mackay Radio & Tel. Co.* v. *Radio Corp.*, 306 U.S. 86, 83 L.Ed. 506 (1939); and *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 220-1, 84 L.Ed. 132, 137 (1940) wherein this Court expressed the view:

> "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been canceled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. . . . The patentee cannot, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. . . . The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive canceled or rejected claims and restore them to their patents are manifest. See Leggett v. Avery, 101 U.S. 256, 259, 25 L.Ed. 865, 866."

Interestingly, the allowed claims in *Schriber-Schroth* were broader than the abandoned ones, and the patentee was attempting to read limitations of abandoned claims into the broader ones to avoid invalidity. In contrast, in the present case the Court is reading *out* limitations expressly inserted to obtain allowance of the claims. We know of no precedent for such delimiting of a claim to find infringement where none existed before.

In finding equivalency in the case at bar, the Court of Appeals made specific reference to its decision in *United Shoe Machinery Corp.* v. *O'Donnell Rubber Products Co.*, 84 F. 2d 383, 386 (6th Cir. 1936), which followed the rule that an express limitation which does not pertain to the inventive step but rather to its mere environment does not preclude reliance on doctrine of equivalents. The *United Shoe* decision is totally inapplicable because the file wrapper history of the prosecution of the patent there involved was not an issue and no facts are set forth in that decision which would indicate that specific narrowing limitations were included in or added to the claims to secure their

allowance. Thus, the Court applied an incorrect and less exacting standard of equivalency than required by *Schriber-Schroth* and *Exhibit Supply Co.*, supra.

Reference was also made by the Court of Appeals to *Graver Manufacturing Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 608, 94 L.Ed. 1097 (1950) for the proposition that under the doctrine of equivalents if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. Here again, the Court is applying a rule which is inapplicable to a claim which was intentionally limited by the patentee.

United Shoe and *Graver*, supra, were the only authorities relied on by the Court of Appeals in finding infringement by equivalency. While that Court fully embraced and followed the principles of *Schriber-Schroth* and *Exhibit Supply Co.*, supra, in a number of earlier decisions, including *Midland Steel Products Co.* v. *Clark Equipment Co.*, 174 F.2d 541, 545 (6th Cir. 1949), it chose in the present case to ignore its own earlier decisions following the principles established by this Court. In particular, we note that the Court of Appeals, in the present case, made specific reference to *Schriber-Schroth* and *Exhibit Supply Co.* in conjunctions with its consideration of sub-issue 3 (which was considered first), but dismissed them as inapplicable to sub-issue 3 on the ground that the District Court had made no express finding of equivalency (A. 31a). Significantly, the Court of Appeals recognized that the defense of file wrapper estoppel applies where infringement is shown under the doctrine of equivalents, yet when the Court reached sub-issue 2, where it *expressly found infringement by equivalency*, it completely disregarded the controlling authorities and applied totally inapplicable and conflicting law. Unless this Honorable Court resolves this

conflict, a dangerous precedent will have been set permitting enlargement of patent monopolies by judicial interpretation.

II. The Conflict With The Reissue Statutes.

The reissue statutes establish the mechanism by means of which a defective patent, including its claims, may be cured. In accordance with 35 U.S.C. § 251, the sole authority for reissue is vested in the Commissioner of Patents, as has been the case since the Patent Act of 1836 (5 Statutes at Large, Chapter 357, p. 117). Section 251 also deals with the specific conditions under which a reissue may be obtained, which include a showing of error without deceptive intentions, whole or partial inoperativeness or invalidity either by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had the right to claim. In the case of a reissue enlarging the scope of the claims, it must be applied for within two years from the grant of the original patent.

There is clear authority that a broadening reissue cannot be properly granted, even within the two year period contemplated by the statute, where the patentee has deliberately added a limitation to a claim to avoid the prior art and then seeks to remove such limitation by way of reissue. Thus, in *Shepard & Others* v. *Carrigan*, 116 U.S. 593, 597 (1886) this Court enunciated the rule as follows:

> "This patent, it will be observed, covers a skirt protector merely, without including any means or method for attaching it to the dress, the purchaser being left to fasten the protector to the dress in her own way.
>
> "It is shown by the evidence in the record that for several years prior to the earliest date assigned by Macdonald for the discovery of her device, in fact as far back as 1857, strips of enamelled cloth without fluting or plaiting had been sewed on the bottom of the skirts of ladies' dresses, so as to project below

the lower edges, with a view of protecting the inside surface and lower edge.

"This fact, and the file-wrapper and contents of which we have stated the substance, make it clear that the claim and specification of the Macdonald patent must be construed to include, as their language requires, a fluted or plaited band or border as one of the essential elements of the invention. Without this element the patent would not have been issued. The Patent Office decided that without it the invention had been anticipated. Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. Leggett v. Avery, 101 U.S. 256; Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 228; Fay v. Cordesman, 109 U.S. 408; Mahn v. Harwood, 112 U.S. 354, 359; Cartridge Co. v. Cartridge Co., 112 U.S. 624, 644; Sargent v. Hall Safe & Lock Co., 114 U.S. 63."

This Court also made it clear in the *Shepard* case that if the patentee accepts claims which are narrower than his invention, his recourse is to appeal the rejection, but having not done so, he could not obtain a reissue based on the broader claim which had been abandoned. Specifically, the Court stated (at 598):

"If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application he is bound by it. If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal. Under the circumstances of this case, the inventor could not even get a reissue based on the broader claim which she had abandoned. Leggett v. Avery, ubi supra. Much less can she, in a suit brought to restrain its infringement, enlarge her patent by argument, so as to cover elements not

> falling within its terms, and which she had explicity abandoned."

The analogy to the present case should be readily apparent. Just as the patentee in *Shepard* sought to broaden her claims to delete the requirement that the skirt protector have plaited or fluted bands or borders, the Court below in the case at bar has deleted from the Gapp claim the requirement that the rivet "will fully clinch the plates *and* completely expand the rivet tail . . . in a single head-forming operation to the finished size of said clinching tail," and also the requirement that the blind head be of "substantially uniform diameter," which language was insisted upon by the Examiner to make it clear that the blind head was devoid of any enlargement or flare which would act to further expand the rivet tail—any such further expansion being inconsistent with the requirement that the tail be expanded to finished size in single head-forming operation prior to wiredrawing.

While obviously the Court below has not formally reissued the Gapp patent in the sense of providing the patentee with a revised patent document, the net effect is the same—the Court has, by judicial interpretation, enlarged the *scope* of the claim to encompass structure which the patentee had expressly disclaimed in order to obtain its allowance. Such judicial enlargement, we submit, is in direct conflict with the reissue statute which sets forth the only procedure by means of which the scope of a claim may be enlarged under any circumstances. In addition, the Court has accorded to the claim a broadened scope which could not have been properly granted to the patentee had he filed a timely application for reissue.

III. The Public Interest Has Not Been Served.

In according to the Gapp patent a scope which is broader than that for which the patent was issued, the public interest has been ill served, as this Court made perfectly

clear many years ago in *Leggett* v. *Avery*, 101 U.S. 256, 259, (1879) wherein it was stated:

> ". . . If, in any case, where an applicant for letters-patent, in order to obtain the issue thereof, disclaims a particular invention, or acquiesces in the rejection of a claim thereto, a reissue containing such claim is valid (which we greatly doubt), it certainly cannot be sustained in this case. *The allowance of claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public.* . . ." (Emphasis added)

Congress has also recognized the rights of the public, and Section 252 of 35 U.S.C. deals with the intervening rights of parties who relied on the limited scope of an original patent before a reissue was allowed. Specifically, the second paragraph of Section 252 provides that any party who made, purchased, or used anything patented by a reissue before the granting of the reissue, is entitled to receive absolute statutory protection. Moreover, the question of intervening rights can only arise when the only claims infringed are claims of the reissued patent which were not in the original. See Federico, Commentary on the New Patent Act, 35 U.S.C. pg. 46 (1954).

The problem of intervening rights reached this Court in *Sontag Stores Co.* v. *Nut Co.*, 310 U.S. 281, 293-4, 84 L.Ed. 1204 (1940), wherein this Court stated:

> "Recapture within two years of what a patentee dedicates to the public through omission is permissible under specified conditions, but not, we think, 'at the expense of innocent parties.' Otherwise, the door is open for gross injustice to alert inventors and baffling uncertainty will hinder orderly development of useful arts.
>
> "The District Court properly ruled that petitioner had 'acquired intervening rights which in equity plaintiff [respondent here] might not now disturb.' "

Our point is that where a claim is broadened by judicial interpretation rather than by the reissue process, the public is being deprived of the protection afforded by Section 252. Clearly, the door has been opened for gross injustice and the exacting of tribute from an unsuspecting public which has acted in good faith on the observation that the patent is limited to specific features which it does not care to use.

Even the Sixth Circuit has previously recognized the rights of the public under such circumstances. In *Ashland Fire Brick Co.* v. *General Refractories Co.*, 27 F. 2d 744, (6th Cir. 1928), which dealt with intervening rights, that Court stated, at 746:

> "There being no presumption that a patent can be reissued, and the special cases where it may be done being relatively few, it does not seem that the public, acting on the faith of things as they are, should carry the burden of a change it has no reason to expect. A competitor, observing that the patent is limited to specific features which he does not care to use, may naturally assume that the limitation was either intentional, or necessary, or both."

Yet by its decision in the case at bar, the Sixth Circuit has abandoned its concern for protecting the public; indeed, the public, including this Petitioner, has been deprived of its right to "act on the faith of things as they are," and in particular, this Petitioner is now being required to "carry the burden of a change it had no reason to expect."

CONCLUSION

We respectfully urge that the questions presented point up serious flaws in the decision by the Court of Appeals which, unless rectified by this Court, will result in gross

injustice and uncertainty in the orderly development of the useful arts.

In departing from the principles laid down by this Supreme Court and even applied by the Court below in its own earlier decisions, the Sixth Circuit Court of Appeals has erred; and in so doing, it has created a direct conflict both with the controlling case law and the reissue statutes.

This petition for a writ of certiorari should be granted.

Respectfully submitted,

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